

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. MACHOVSKY

Appeal No. 2003-0541
Application No. 09/645,845

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-17,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a multi-purpose plumbing tool. An understanding of the invention can be derived from a reading of exemplary claim 13, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kuhn	3,738,768	Jun. 12, 1973
Rogers	5,440,957	Aug. 15, 1995
Bayouth	5,996,447	Dec. 7, 1999

Claims 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayouth in view of Rogers.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayouth in view of Rogers and Kuhn.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 8) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 7) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

As explained on pages 2 and 3 of the specification, the appellant's invention provides two different sized tubular wrench sockets, each of having four notches at its operating end which can accommodate a square head of a pipe fitting plug or the radially extending spokes of a bathtub drain or the like, with the larger of the two sockets being attachable to and driveable by the smaller (see Figures 1, 5 and 7). The configuration of the wrenches is such that they can be passed through an opening in a wall, or through the pipe leading to, the items to be worked. The lower portion of the second (larger) socket is receivable in the four notches in the upper portion of the first (smaller) socket. According to claim 13, the first tubular socket and its notches are sized to accommodate parts used with 1½ inch nominal diameter pipe and the larger to accommodate parts used with 2 inch nominal diameter pipe.

The examiner has rejected independent claim 13 under 35 U.S.C. § 103(a) as being obvious in view of the combined teachings of Bayouth and Rogers. In arriving at this conclusion, the examiner has found that Bayouth discloses the claimed invention "except for the use of a second socket of a different size to be secured to the working end of the first socket tube in order to provide for a set that is usable on larger sized elements." However, the examiner is of the view that it would have been obvious to one of ordinary skill in the art to have modified Bayouth by using a larger second socket

with the same working end because “Rogers suggests the use of such a set of sockets to allow use of the set on various sized elements.” Answer, page 3.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Applying this guidance to the situation at hand leads us to conclude that the rejection of claim 13 cannot be sustained. Our reasoning follows.

Bayouth is directed to a wrench for removing hard-to-reach nuts from faucets (see Figure 2). The wrench comprises a cylindrical pipe 11 and a socket 16. The cylindrical pipe has notches 12-14 at one end and holes 17 and 18 at the other end. The socket has an inner opening configured to accommodate the nut or other item to

be turned and four radially outwardly projecting studs 12a-15a. The studs are received in the notches, in which position they can be rotated by rotating the pipe, either by hand or by means of an object inserted through the holes in the other end. There is no teaching in Bayouth that the notches in the pipe are used to engage anything other than the studs protruding from the socket, and no dimensions are given, except that the diameter of the opening in the socket and that of the pipe are sufficient to allow these two elements to pass over a water supply line (column 3, line 6 et seq.).

With regard to claim 13, Bayouth fails to disclose or teach a first tubular socket having four notches for receiving a workpiece comprising parts used with 1½ inch nominal diameter pipe. Nor does Bayouth disclose or teach a second tubular socket having four notches for receiving parts used with 2 inch nominal diameter pipe, and rib means on its interior surface for engaging the notches of the first socket.

Rogers discloses an oil filter wrench. Although the examiner has not directed us to any particular portion of the specification or drawing, with reference to Figure 2, the Rogers device comprises a driver adaptor 35 that can be engaged with the outer surface of a driver 33 in order to accommodate oil filters that will fit the configuration present in the smaller cavity thereof, or it can be engaged with the inner surface of driver 33 in order to allow the driver to receive oil filters configured to fit the larger cavity (column 4 and 5). Figures 11 and 12 show another embodiment, wherein the driver adapter 97 can be engaged with a number of drivers 71 having different sizes and

interior configurations (columns 5 and 6). Rogers does not utilize the driver adaptor as a socket for accommodating a workpiece other than the oil filter wrench, which engages the workpiece. The driver adaptor is used only as a means for driving a plurality of oil filter wrenches of different sizes and configurations, which are selected to accommodate the oil filter being worked upon.

The examiner has not explained how the Bayouth wrench would be modified by the teachings of Rogers in order to meet the terms of claim 13, nor has any comment been made regarding the limitations directed to the sizes of the complementary parts engagable by the first and second sockets. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive in either Bayouth or Rogers which would have led one of ordinary skill in the art to modify the Bayouth cylindrical device in such a manner as to meet the terms of the claim, especially when considering that the first ends of the “first sockets” in both of the references are designed only to accommodate the configuration of the “second sockets” and not of the second sockets in addition to work pieces having the limitations recited in the claim.

It therefore is our conclusion that the combined teachings of Bayouth and Rogers fail to establish a prima facie case of obviousness with regard to the subject

matter recited in claim 13, and we will not sustain the rejection of this claim or, it follows, of claims 14 and 15, which depend therefrom.

The rejection of claims 16 and 17 also will not be sustained. The addition of Kuhn, which was cited for teaching side holes in a wrench drive to receive a handle, fails to overcome the aforementioned problems with Bayouth and Rogers.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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APPEAL NO. 2003-0541 - JUDGE ABRAMS
APPLICATION NO. 09/645,845

APJ ABRAMS

APJ NASE

APJ COHEN

DECISION: **REVERSED**

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DRAFT TYPED: 15 Apr 04

FINAL TYPED: